

on the examiner in examining all of the claims must also be shown. According to 35 U.S.C. § 121, "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner *may* require the application to be restricted to one of the inventions" (emphasis added). Similarly, MPEP § 806.05, states that if two are more inventions are distinct, "restriction *may* be proper" (emphasis added). Therefore, these provisions indicate that, in some instances, restriction may not be proper where two distinct inventions are claimed in an application.

The standard for determining when restriction is proper is set forth in MPEP § 803. According to this section,

"[i]f the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, *even though it includes claims to distinct or independent inventions.*" (emphasis added).

Thus, the MPEP explicitly requires the Examiner to examine the claims if no serious burden exists.

In the instant case, Applicants respectfully submit that examining claims of Groups II, III, IV, and the new claims 75-105 in addition to the elected claims of Group I would not create a serious burden. The claims of Group I (claims 1-27) are directed to reaction mixture comprising an acceptor saccharide and a first type of cell that produces a nucleotide sugar and a recombinant glycosyltransferase. The claims of Group II (claims 28-30), which depend from claim 1, simply add to this reaction mixture an additional enzymatic system producing at least a second nucleotide sugar and a second recombinant glycosyltransferase. Therefore, searching for the reaction mixture of the Group I claims would necessarily find all references that describe reaction mixtures that have two such enzymatic systems.

Similarly, the claims of Group III (claims 31-39), which also depend from claim 1, simply add the element that the reaction mixture comprises two different types of cells, each producing a nucleotide sugar and a glycosyltransferase. Again, a search for the reaction mixture of the Group I claims, which include at least one type of cell that produces a nucleotide sugar and a glycosyltransferase, would necessarily identify those references that have a second cell type that also produces a nucleotide sugar and a glycosyltransferase. No additional burden would be involved.

The claims of Group IV (claims 40-71) are directed to cells that are found in the reaction mixtures of claim 1 and methods for making a saccharide using said cells. A search for the reaction mixture of claim 1 would identify references that describe such cells, if such references existed.

The differences among the subject matter in each of the groups which are set forth in support of the restriction requirement do not really have any impact on the burden of performing a search. Applicants respectfully submit that, because a search by the PTO no longer requires an examiner to physically search the shelves for each class and subclass, but rather only requires a computer search, no serious burden exists in searching all of the pending claims. Indeed, the restriction requirement does not make any allegation that a serious burden would result from examining all of the claims. In the absence of a serious burden, the restriction requirement is improper and should be withdrawn.

#### CONCLUSION

In view of the foregoing, Applicants believe that all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned attorney at (415) 576-0200.

Respectfully submitted,



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